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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,382	09/27/2006	Pasquale Angione	171.008	7824
38245 7590 01/07/2008 JEROME D. JACKSON (JACKSON PATENT LAW OFFICE) 211 N. UNION STREET, SUITE 100 ALEXANDRIA, VA 22314			EXAMINER ADDISU, SARA	
			ART UNIT 3722	PAPER NUMBER
			MAIL DATE 01/07/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/599,382

Applicant(s)

ANGIONE, PASQUALE

Examiner

Sara Addisu

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

### ***Drawings***

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore,
  - the "two independent workpiece-holding slides" (as claimed in claim 4, lines 13-14. Note: referring to the Specification (page 9, paragraph 55), the two slides (110, 120) support the tool holding electro-spindles, not "workpiece-holding slides" as claimed,
  - the "sensor or equivalent device" (as claimed in claim 7, and mentioned in Spec, page 11, paragraph 68)
  - the "two supports" (claim 3: note, figure 2 shows the supports as arrows, there is no structural explanation of how it is supported.
  - must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. The abstract of the disclosure is objected to because it is in claim format.

Correction is required. See MPEP § 608.01(b).

3. The disclosure is objected to because of the following informalities:

- page 10, Paragraph 60, line 2 describes references "221, 231" as "turning plate" while Paragraph 63, line 2 describes references "221, 231" as "motorized plate".
- Page 11, Paragraph 67, line 5 describes reference "320" as "workpiece". It should be "300".

Appropriate correction is required.

#### ***Claim Objections***

4. Claims 1 and 5 are objected to because of the following informalities:

- claim 5 and claim 1 (line 9) recite " A machining method for a long workpiece (300) such as a workpiece...". Examiner suggests that the phrase " such as a workpiece" should be deleted since " a long workpiece" already claims the workpiece (i.e. currently repetitive without further limiting the claim".
- Claim 1 (line 12) recites the limitation "the two independent workpiece-holding slides". The word "the" should be deleted.
- 

Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

- Claim 1 (lines 13-14) recite "... the actuation of the two independent workpiece-holding slides (110 and 120) in a manner in which the machining of the two ends of the workpiece (300) are carried out by a different slide". Referring to the Specification (page 9, paragraph 55), the two slides (110, 120) support the tool holding electro-spindles, not "workpiece-holding slides" as claimed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 4 (lines 13-14) recite "... the actuation of the two independent workpiece-holding slides (110 and 120) in a manner in which the machining of the two ends of the workpiece (300) are carried out by a different slide". Referring to the Specification (page 9, paragraph 55), the two slides (110, 120) support the tool holding electro-spindles, therefore, for the purpose of this Office Action, Examiner interprets it to be "slides that support tool holding splindles" and not "workpiece-holding slides" as claimed.
- Claim 3 recites, "two supports" Further review of figure 2 shows the supports as arrows, there is no structural explanation of how it is supported.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1- 7, as best understood, are rejected under 35 U.S.C. 102(e) as being anticipated by Grob (USP 7,150,706).

Regarding claims 1 and 6, GROB teaches a machining tool with a workpiece holding device having an axis of rotation (A) (that is transverse with respect to the downward axis (Y), whereby the workpiece holding device (200) is constituted by a frame (19) supporting two bearings (103, 104) for rotationally guiding a workpiece (2) to be machined (i.e. the workpiece is turned according to its longitudinal axis (A) during the machining operations, also see '706, col. 23, lines 66-67), the ends of which being fixed to opening (105) of the bearings (103, 104) ('706, figures 28 & 29 and col. 23, lines 45-67). GROB also teaches two independent slides that support tool holding spindles (30, 30') such that a two sided machining of the workpiece can be carried out by conveying the spindle in the X and Z axis (i.e. the machining of the two ends of the workpiece are carried out by a different slide and therefore GROB's tool is capable of machining the workpiece at its two opposite ends) ('706, figures 28 and 29 col. 23, lines 49-52).

Regarding the phrase "the workpiece to be machined being a long workpiece" (claim 1) and "a machining method for a long workpiece" (claim 5), do not further limit the claimed and are merely functional/intended use statements not defining any specific structure. It should be noted that it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. The only requirement is that the prior art reference be capable of said intended use. See MPEP 2114. Regarding claims 2 and 4, GROB teaches each bearing (103,104) includes and guides a rotating plate (4, 4') having a motorized actuation means that can

rotate the workpiece around at least one rotational axis (A) as well as another axis (B: that is perpendicular to the A axis), whereby the rotation of the two plates (4, 4') being synchronized ('706, col. 23, line 64 through col. 24, line 4). Regarding claim 3, GROB teaches guides (15) are provided on the towers/bearings (103, 104), the guides serving the plates (4, 4'), thus Examiner is defining the guides (15) as the first support and the bearings as the second support ('706, col. 23, lines 64-65). Regarding claim 5, GROB teaches machining operations being carried out up to four axes of movement ( Z axis, X axis, axis of rotation A axis and rotational axis of the tool spindle) . Regarding claim 7, as best understood, GROB teaches that at least a part of the workpiece can be moved or rotated differently, therefore given the fact that machining operations can be carried out up to four axes of movement, the tool is able to determine the symmetry of the workpiece.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sara Addisu at (571) 272-6082. The examiner can normally be reached on 8:30 am - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on (571) 272-4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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